

REMARKS/ARGUMENTS

Claims 1-8 and 16-28 are pending in this Application.

Claims 1, 16, and 24 are currently amended. Applicants submit that support for the claim amendments and the newly added claims can be found throughout the specification and the drawings. Claims 1-8 and 16-28 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-4, 6, 7, 16-19, 21, 22 and 24-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. U.S. Patent 5,706,097 to Schelling et al. (hereinafter "Schelling"), in view of U.S. Patent No. 5,485,554 to Lowitz et al. (hereinafter "Lowitz"). Claims 5, 20, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schelling and Lowitz, and in further view of U.S. Patent No. 5,857,185 to Yamaura (hereinafter "Yamaura"). Claims 7 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schelling and Lowitz, in further view of U.S. Patent No. 6,098,082 to Gibbon et al. (hereinafter "Gibbon").

Interview Summary

Applicants respectfully thank the Examiner for extending an interview to Applicant's undersigned representative on Feb. 15, 2007. No agreement as to allowance of some or all of the claims, or removal of prior art cited in rejections was reached.

In regard to claim 1, Applicants' representative argued that both Schelling and Lowitz, fail to teach or suggest printing a thumbnail image representing a page of a multimedia paper document on a paper medium to generate a coversheet.

Schelling is directed to printing a reduced sized version (or thumbnail image) of a still-image or frame extracted from a video sequence on an index print. In Schelling, the index print includes thumbnail images, or other textual and iconic information that represent data files (e.g., still-images, audio files, and video files) as stored on a disk. As discussed further below, the printing in Schelling of a thumbnail image that has been extracted from a video sequence to represent the video sequence is substantially different from printing a thumbnail image

representing a page of a multimedia paper document on a paper medium to generate a coversheet as recited in claim 1.

Lowitz is directed to printing video prints on paper. In Lowitz, frames of video sequences can be extracted, and resized (e.g., into a thumbnail image) for printing on paper. As discussed further below, the printing in Lowitz of a thumbnail image that has been extracted from a video sequence is substantially different from printing a thumbnail image representing a page of a multimedia paper document on a paper medium to generate a coversheet as recited in claim 1.

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-4, 6, 7, 16-19, 21, 22 and 24-27 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Schelling and Lowitz. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Schelling with the teachings of Lowitz.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a *prima facie* showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants respectfully submit that based on the following discussion, Schelling and Lowitz, either individually or in combination, fail to teach or suggest at least one of the claim limitations recited in each of claims 1-4, 6, 7, 16-19, 21, 22 and 24-27.

Claim 1

Amended claim 1 recites a computer-implemented method of generating a coversheet for a multimedia paper document, the multimedia paper document comprising one or

more pages, wherein a printable representation of multimedia information is printed on each page of the one or more pages of the multimedia paper document, the multimedia information comprising video information, the method comprising:

receiving, for each page of the one or more pages of the multimedia paper document, a thumbnail image representing the page of the multimedia paper document; and
printing, for each page of the one or more pages of the multimedia paper document, the thumbnail image representing the page of the multimedia paper document on a paper medium to generate the coversheet.

As recited above, a printable representation of multimedia information, including video information, is printed on each page of a multimedia paper document. For each page of the multimedia paper document, a thumbnail image is received that represents the page of the multimedia paper document. For each page of the multimedia paper document, the thumbnail image representing the page of the multimedia paper document is printed on a paper medium to generate a coversheet for the multimedia paper document.

As recited above, the thumbnail image represents a page of a multimedia paper document. Furthermore, the thumbnail image represents a page of a multimedia paper document, where a printable representation of multimedia information, including video information, is printed on each page of the multimedia paper document. Thus, the thumbnail image represents a page on which a printable representation of at least video information and one other type of information is printed.

For the purposes of illustration, FIGS. 16A, 16B, 16C, and 16D of the Application depict pages of a multimedia paper document. As discussed in the Application, the document generated by printing a printable representation of multimedia information on a paper medium will be referred to as the “multimedia paper document. (Application: Paragraph [0050]). The multimedia paper document takes advantage of the high resolution and portability of paper and provides a readable representation of the multimedia information.

The pages depicted in FIGS. 16A, 16B, 16C, and 16D of the Application may be in different multimedia paper documents or in the same multimedia paper documents. If each of the pages depicted in FIGS. 16A, 16B, 16C, and 16D are considered to be pages of one

multimedia paper document, for example, the multimedia paper document then includes 4 pages (i.e., page 1 depicted in FIG. 16A, page 2 depicted in FIG. 16B, page 3 depicted in FIG. 16C, and page 4 depicted in FIG. 16D).

For the purposes of illustration, FIG. 17 depicts a coversheet generated for a multimedia paper document. In general, the coversheet may also include one or more pages depending in part on the number of pages of a multimedia paper document for which the coversheet is generated. If a coversheet as depicted in FIG. 17 is generated for the 4 page multimedia paper document in the previous example depicted by the pages of FIGS. 16A, 16B, 16C, and 16D, for example, the coversheet depicted in FIG. 17 would include reduced size versions images for each page (or thumbnails) representing each page of the 4 page multimedia paper document. In other words, FIG. 17 would include a thumbnail representing the page depicted in FIG. 16A, a thumbnail representing the page depicted in FIG. 16B, a thumbnail representing the page depicted in FIG. 16C, and a thumbnail representing the page depicted in FIG. 16D. The coversheet would include at least four thumbnails representing the four pages of the 4 page multimedia paper document.

Applicants respectfully submit that Schelling and Lowitz, either individually or in combination, fail to teach or suggest receiving and printing the thumbnail image as recited in claim 1 that represents a page of a multimedia paper document to generate a coversheet for the multimedia paper document.

In the Office Action, the Examiner acknowledges that Schelling fails to disclose printing thumbnail images representing each page of a multimedia paper document to generate a coversheet as recited in claim 1. The Office Action relies upon Lowitz for its teaching as allegedly disclosing the above-recited feature. Applicants respectfully disagree. Lowitz fails to cure the deficiencies of Schelling, and fails to teach or suggest receiving and printing the thumbnail image as recited in claim 1 that represents a page of a multimedia paper document to generate a coversheet as recited in claim 1.

Thumbnail Image Representing a Page of a Multimedia Paper Document

Amended claim 1 recites “receiving, for each page of the one or more pages of the multimedia paper document, a thumbnail image representing the page of the multimedia paper document.” As recited in claim 1, the thumbnail image represents a page of the multimedia paper document. One each page of the multimedia paper document, a printable representation of multimedia information is printed. The multimedia information includes at least video information. Thus, each page of the multimedia paper document is printed with a printable representation of multimedia information having at least video information and one other type of information. Applicants respectfully submit that Schelling and Lowitz, either individually or in combination, fail to disclose receiving a thumbnail image representing a page of a multimedia paper document as recited in claim 1.

Schelling discloses that an operator selects still-images or frames from a video sequence, and the selected still-images and frames can be deduced to the “thumbnail image” size, and arranged on an index print. (Schelling: Col. 3, lines 33-36). In Schelling, the thumbnails images (i.e., reduced sized versions of the original still-images and extracted frames) on the index print represent the still-image or the video sequence as stored on a digital medium. (Schelling: Col. 1, line 64 to Col. 2, line 4). Thus, in Schelling, a still-image or video frame is reduced to → a thumbnail image representing the still-image or the video frame (or the video sequence from the video frame was extracted), and → the thumbnail image representing the still-image or video sequence is then placed on the index print for printing.

As acknowledged by the Examiner, Schelling fails to disclose printing thumbnail images representing each page of a multimedia paper document, and thus fails to disclose receiving thumbnail images representing each page of a multimedia paper document as recited in claim 1. Schelling fails to teach or suggest receiving and printing a thumbnail image as recited in claim 1 that represents a page of a multimedia paper document, because Schelling is direct to thumbnail images that represent still-images and frames extracted from videos for printing on the index page of Schelling. The thumbnail images in Schelling that represent still-images from multimedia information (e.g., still-images and frames extracted from videos which is one type of information) are different from thumbnail images as recited in claim 1 that represent pages of

multimedia paper documents, on which is printed video information and one other type of information.

However, in the Office Action, the Examiner alleges that Schelling teaches that the index print may be used to print an image (or thumbnail) of “the document (page, index print).” (Office Action dated Sept. 20, 2006: Section 3, paragraph 1). As discussed above, Schelling discloses printing an index print with thumbnail images that represent video sequences stored on a disk. The Examiner must mean that “the document” in Schelling is the data files (e.g., a video sequence file) stored on disk, and not a page of the index print as allegedly emphasized in parenthesis, nor a multimedia paper document as recited in claim 1. Accordingly, an operator in Schelling extracting a frame from a video sequence to generate a reduced sized version of the frame to create a thumbnail image that represents the video sequence stored on a digital medium is substantially different from receiving a thumbnail image representing a page of a multimedia paper document as recited in claim 1.

Lowitz discloses a device to provide plain paper prints of video images extracted from video sequences. (Lowitz: Col. 2, lines 8-11). In Lowitz, a user can print single frames or selected sequence of frames of video images on paper. (Office Action: Page 4, lines 1-4). Lowitz further disclose that the user can add textual or iconic representations on a page in addition to the frames of video images before printing. (Lowitz: Col. 11, lines 44-67). Thus, in Lowitz, a still-image or video frame is reduced to → a thumbnail image representing the still-image or the video frame (or the video sequence from the video frame was extracted), and → the thumbnail image representing the still-image or video sequence is then printed on paper.

As with Schelling, an operator in Lowitz selecting a still-image or frame to be extracted from a video sequence, and then printing a reduced sized version of the frame on paper to generate a thumbnail image representing the frame is substantially different from receiving a thumbnail image representing a page of a multimedia paper document as recited in claim 1. The thumbnail image as recited in claim 1 represents a page of a multimedia paper document. The thumbnail image recited in claim 1 represents a page of a multimedia paper document, on which a printable representation of multimedia information is printed. Moreover, the thumbnail image recited in claim 1 represents a page of a multimedia paper document, on which is printed

multimedia information including at least video information and one other type of information. Accordingly, an operator in Lowitz extracting a frame from a video sequence to generate a reduced sized version of the frame to create a thumbnail image that represents the video sequence is substantially different from receiving a thumbnail image representing a page of a multimedia paper document as recited in claim 1.

Moreover, the thumbnail images in Schelling and Lowitz are merely still-images extracted from the video sequence. The thumbnail image in Schelling and Lowitz include one type of information, for example, a still-image frame. A thumbnail image in Schelling and Lowitz that includes only one type of information is substantially different from the thumbnail image as recited in claim 1 that represents a page of a multimedia paper document, on which is printed more than one type of information (e.g., video information and at least one other type of information).

Thus, Applicants respectfully submit that Schelling and Lowitz fail to teach or suggest the feature of receiving, for each page of the one or more pages of a multimedia paper document, a thumbnail image representing the page of the multimedia paper document as recited in claim 1.

Printing a Thumbnail Image Representing a Page

Claim 1 recites that for each page of the one or more pages of the multimedia paper document, a thumbnail image representing the page of the multimedia paper document is received. As a result, the thumbnail image representing the page is printed on a paper medium to generate a coversheet as recited in claim 1.

In the Office Action, the Examiner acknowledges that Schelling fails to disclose printing thumbnail images representing each page of a multimedia paper document to generate a coversheet as recited in claim 1. The Office Action relies upon Lowitz for its teaching as allegedly disclosing the above-recited feature. Applicants respectfully disagree. Lowitz fails to cure the deficiencies of Schelling and fails to teach or suggest printing thumbnail images representing each page of a multimedia paper document to generate a coversheet as recited in claim 1.

As discussed previously, Lowitz merely discloses a device to provide plain paper prints of video images extracted from video sequences. (Lowitz: Col. 2, lines 8-11). In Lowitz, a user can print single frames or selected sequence of frames of video images on paper. (Office Action: Page 4, lines 1-4). Lowitz further discloses that the user can add textual or iconic representations to the frames of video images before printing. (Lowitz: Col. 11, lines 44-67).

Applicants respectfully submit that printing in Lowitz of a reduced sized version of a frame of video does not teach or suggest printing the thumbnail image as recited in claim 1 that represents a page of a multimedia paper document. Instead, Lowitz merely discloses that frames of video images are extracted from the video sequences, and then can be resized (e.g., into a thumbnail). The thumbnail frames of video images in Lowitz then are positioned and printed on paper. The printing of thumbnail frames of video image extracted from video sequences as in Lowitz does not teach or suggest that a thumbnail image representing a page of a multimedia paper document is printed as recited in claim 1. Furthermore, in Lowitz, the thumbnail images of video images at best possibly represent still-images extracted from the video sequences, and at best represent the video sequences.

Therefore, Applicants respectfully submit that Schelling and Lowitz fail to teach or suggest the feature of printing, for each page of the one or more pages of the multimedia paper document, the thumbnail image representing the page of the multimedia paper document on a paper medium to generate the coversheet as recited in claim 1. Thus, Applicants respectfully submit that claim 1 is patentable over Schelling and Lowitz.

Claims 2-8 and 16-28

Applicants respectfully traverse the rejections to claims 5, 20, and 28 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Schelling, Lowitz, and Yamaura. Yamaura fails to cure the deficiencies Schelling and Lowitz for at least a similar rationale as discussed above for the allowability of claim 1, and others.

Applicants respectfully traverse the rejections to claims 7 and 22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Schelling,

Lowitz, and Gibbon. Gibbon fails to cure the deficiencies Schelling and Lowitz for at least a similar rationale as discussed above for the allowability of claim 1, and others.

Applicants further submit that independent claims 16 and 24 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others.

Applicants submit that dependent claims 2-8, 17-23, and 25-28 that depend directly and/or indirectly from the independent claims 1, 16, and 24 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Sean F. Parmenter/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
SFP:sfp
60961781 v1